

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket

Janice L. Jones

US040138US

Application No.: 10/599,112

Int'l Appln. No.: PCT/IB2005/050927

Int'l File Date: 03/16/2005

Title: DEFIBRILLATION ELECTRODE HAVING DRUG
DELIVERY CAPABILITY

I hereby certify that this correspondence is being deposited with the
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on December 5, 2006
(Date of Deposit)

W. Brinton Yorks, Jr.

Name of applicant, assignee, or
Registered Representative

W B Brinton Yorks, Jr.
(Signature)

12/5/06
(Date of Signature)

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

REQUEST FOR RECONSIDERATION OF
PETITION WHEN INVENTOR REFUSES TO SIGN DECLARATION

Sir:

On 20 September 2006 applicants filed the above identified request for entry into the national stage in the United States of the above identified international application. This request was accompanied by a petition under 37 CFR §1.47(a) to accept a declaration when one of the inventors refuses to sign the declaration.

In a decision on this petition mailed 12 October 2006, a copy of which is attached hereto, the Attorney Advisor found that the petition was complete except for a statement of the last known address of the missing inventor. Applicants' attorney was given two months to request reconsideration of the petition if desired.

It was believed that the requirement to furnish the last known address of the nonsigning inventor was satisfied in the original petition, as the petition was accompanied by a copy of the letter sent to the last known address of the missing inventor. However, to make it completely clear what this address is, a copy of the petition is enclosed which has been amended to contain a clear statement of the last known address of the missing inventor, Dr. Janice L. Jones. It is respectfully requested that the Commissioner reconsider and approve the petition and accept this patent application without the signature of Janice L. Jones.

Respectfully submitted,

By: W Brinton Yorks, Jr.
W. Brinton Yorks, Jr.
Reg. No. 28,923

Philips Electronics
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P.O. Box 3003
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December 5, 2006

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Title: DEFIBRILLATION ELECTRODE HAVING DRUG
DELIVERY CAPABILITY

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

PETITION WHEN INVENTOR REFUSES TO SIGN DECLARATION

Sir:

It is respectfully requested that the Commissioner permit the filing of this application with a Declaration signed by one of the two co-inventors, David E. Snyder, when the other co-inventor, Janice L. Jones, refuses to sign the Declaration. The underlying facts are as follows.

1. On July 1, 1999 Janice L. Jones entered into a Consulting Agreement with Hewlett-Packard Company (HP), the predecessor to the assignee of David E. Snyder, Philips Electronics. A copy of this Consulting Agreement is attached hereto. Under paragraph 5 of the Consulting Agreement, Dr. Jones agreed to disclose promptly any inventions made by her during the term of the Agreement. Paragraph 5 also provides that inventions developed jointly from joint contributions by HP (in the person of David E. Snyder) and Dr. Jones shall be owned jointly by Dr. Jones and HP. The present invention was developed jointly by Mr. Snyder and Dr. Jones under this Consulting Agreement.
2. A provisional application covering the present invention, serial no. 60/556,220 was filed on March 25, 2004. The form of the provisional application was

subsequently used for a PCT filing and for the present application in the national stage of the PCT filing.

3. On May 18, 2004 Philips Medical Systems, successor to HP by acquisition of the HP business, notified Dr. Jones that the July 1, 1999 Consulting Agreement was being terminated. A copy of the termination letter is attached hereto.

4. On May 6, 2004 the undersigned, attorney for Philips Medical Systems, sent the attached letter to Dr. Jones. This letter enclosed a Declaration form for Dr. Jones to sign. Dr. Jones never returned the Declaration.

5. On August 31, 2006 the undersigned sent another letter and Declaration form to the last known address of Dr. Jones for signing, a copy of which is enclosed. This letter was sent by return receipt postcard, a copy of which is enclosed. This postcard was signed upon delivery of the letter and returned to the undersigned. Dr. Jones has not returned this Declaration, either.

6. The last known address of the nonsigning inventor is:

Dr. Janice L. Jones
24110 Clarksburg Road
Clarksburg, Maryland 20871

7. Should Dr. Jones return the signed Declaration it will be promptly filed in this application. In the meantime, it is respectfully requested that this application be allowed to proceed with the Declaration signed only by co-inventor David E. Snyder.

8. Please charge Deposit Account no. 14-1270 for the petition fee required by 37 CFR §1.17(g).

Respectfully submitted,

By: W Brinton Yorks, Jr.
W. Brinton Yorks, Jr.
Reg. No. 28,923

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12 OCT 2006

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OCT 16 2006

J. PEISTRUP

In re Application of
JONES et al.
Application No.: 10/599,112
PCT No.: PCT/IB05/50927
Int. Filing: 16 March 2005
Priority Date: 25 March 2004
Attorney Docket No.: US040138US
For: DEFIBRILLATION ELECTRODE
HAVING DRUG DELIVERY
CAPABILITY

DECISION ON PETITION

18 Nov 1mo.
12 Dec 2mos.

This decision is issued in response to applicants' "Petition (under 37 CFR 1.47(a)) when Inventor Refuses to Sign Declaration" filed 20 September 2006 to accept the application without the signature of joint inventor, Janice L. Jones. The requisite \$200 petition fee has been submitted.

BACKGROUND

On 16 March 2005, applicants filed international application PCT/IB05/50927, which claimed a priority date 25 March 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 06 October 2005. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 25 September 2006.

On 20 September 2006, applicants filed a request for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and the present petition under 37 CFR 1.47(a).

SCANNED

17 OCT. 2006

18 OCT 17 2006

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1); (2); and (4) have been satisfied.

A review of the present petition reveals that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Philippe Renaudin. The steps taken by W. Brinton Yorks are sufficient to show that Janice L. Jones has refused to execute the application.

Regarding item (3) above, a clear statement of the last known address of the nonsigning inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. (See MPEP §605.03)

For the above reasons, it would not be appropriate to accept this application without the signature of Janice L. Jones at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

~~If reconsideration on the merits of this petition is desired, a proper response must be~~
filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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